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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,875	09/25/2000	Jerry Freestone	NTL-3.2.133/3405	3055
26345	7590		(12052SC)	
GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE 1 RIVERFRONT PLAZA NEWARK, NJ 07102-5497			EXAMINER WON, YOUNG N	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 02/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/668,875

Applicant(s)

FREESTONE ET AL.

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-45 have been examined and are pending with this action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10, 12-19, 21-31, 33-41, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al. (US 5732216 A).

#### **INDEPENDENT:**

As per claim 1, Logan teaches an electronic message comprising: sound file (see col.42, line 67 to col.43, line 2); and, predetermined identifier indicating an aspect of said sound file (see col.15, lines 15-19; col.44, lines 12-15; and col.45, lines 52-54).

As per claim 8, Logan teaches a method for sending an e-mail comprising: attaching a sound file to an e-mail (see col.42, line 67 to col.43, line 2); and utilizing a predetermined identifier indicating an aspect of said sound file into said email (see col.15, lines 15-19; col.44, lines 12-15; and col.45, lines 52-54).

As per claim 24, Logan teaches a method for announcing electronic messages comprising: receiving an electronic message with an attached sound file (see col.42, line 67 to col.43, line 2); noting the presence of a predetermined identifier indicating an aspect of said sound file (see col.15, lines 15-19; col.44, lines 12-15; and col.45, lines 52-54); and, playing the attached sound file (see col.1, lines 42-46).

DEPENDENT:

As per claims 2-4, 14-16, and 26-28, Logan further teaches wherein said sound file contains at least one word in a computer-simulated voice and at least one word in a sender's voice (see col.28, lines 19-26).

As per claim 5, Logan further teaches wherein the predetermined identifier is a specific file name associated with said sound file (see col.5, lines 6-15).

As per claims 6, 17, and 29, Logan further teaches wherein the predetermined identifier is an information tag (see col.44, lines 12-15).

As per claims 7, 18, and 30, Logan further teaches wherein the information tag is embedded in the e-mail header (see col.43, lines 5-15).

As per claim 9, Logan further teaches wherein said attaching, is performed by a computer at a sending party's end (see col.15, lines 15-19).

As per claim 10, Logan further teaches wherein said attaching is automatic (see col.10, lines 28-36).

As per claim 12, Logan further teaches wherein said attaching, is performed by an e-mail server (see col.4, lines 40-46 and col.6, lines 39-41).

As per claim 13, Logan further teaches wherein said attaching is, performed by a recipient computer (see col.2, lines 10-14 and col.15, lines 15-19).

As per claims 19 and 31, Logan further teaches wherein the information tag, is embedded by a sender computer (see col.43, lines 26-33 & 46-60 and col.44, lines 12-15).

As per claims 21 and 33, Logan further teaches wherein the information tag, is embedded by an e-mail server (see claim 7 and 19 rejection above).

As per claim 22 and 34, Logan further teaches wherein the information tag, is embedded by a recipient computer (see claim 13 and 19 rejection above).

As per claim 23, Logan further teaches wherein said attaching, is selectively performed by a sending party (see col.11, lines 27-34).

As per claim 25, Logan teaches of further comprising receiving at least one more electronic message with an attached sound file and playing said at least one more sound file (see col.7, lines 51-61).

As per claim 35, Logan further teaches wherein said playing is selective (see col.46, lines 26-28).

As per claim 36, Logan further teaches wherein said playing is performed at a recipient computer (see col.1, lines 42-49).

As per claim 37, Logan further teaches wherein said playing is performed at a recipient customer premise equipment (see col.1, lines 42-49)

As per claim 38, Logan further teaches where said playing is performed at a recipient voice mail (see col.15, lines 31-46).

As per claim 39, Logan teaches of further comprising converting the content of the electronic message to a voice message (see col.28, lines 19-26).

As per claim 40, Logan further teaches where said converting is performed at an e-mail server (see col.5, lines 26-31).

As per claim 41, Logan further teaches where said converting is performed at a recipient computer (see col.5, lines 16-26).

As per claim 44, Logan further teaches wherein said converting is performed using a sound file as a voice sample.

As per claim 45, Logan teaches of further comprising transferring said voice message to a voice mailbox (see col.15, lines 31-46 and col.29, lines 36-41).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11, 20, 32, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (US 5732216 A) in view of Agraharam et al. (US 6085231 A).

As per claims 11, 20, 32, and 42, Logan further teaches wherein said attaching is performed by a computer at a sending party's end (see claim 9 rejection above),

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wherein the information tag is embedded by a computer at a sending party's end (see claim 7 rejection above), and wherein said converting is performed at a computer at the receiving party's end. Logan does not explicitly teach of an adjunct to a sender or a receiver for performing these steps. Agraharam teaches of an adjunct (see col.3, lines 20-29). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Agraharam within the system of Logan by implementing adjunct devices or means for performing each function by means of adjunct devices or servers or the like within the method for sending an e-mail or announcing and electronic message because such an implementation would increase performance to compensate for larger or increase in the number of users or members and an increase in sound file size by dedicating specific servers to perform specific tasks.

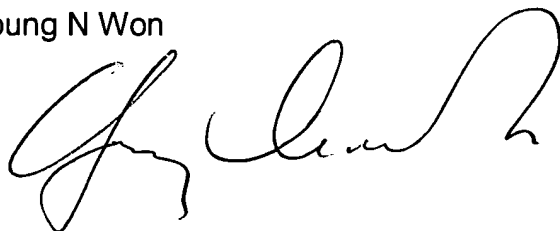
As per claim 43, Logan does not explicitly teach wherein said converting is performed at a voice messaging system. Agraharam teaches wherein said converting is performed at a voice messaging system (see Fig.2, #202 & #206 and col.4, lines 7-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Agraharam within the system of Logan by implementing conversion to be performed at a voice messaging system within the method for sending an e-mail or announcing and electronic message because Logan teaches of voice messages (see col.29, lines 39) and explains how conversion is preferable at the client station to quickly download text files rather than audio files which are larger thus increasing transmission time (see col.5, lines 16-26).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Young N Won



February 2, 2004



**PATRICE WINDER**  
**PRIMARY EXAMINER**